



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/888,462	07/07/97	SCHARF	C 2730-01

IM12/0529

EXAMINER

MCAVOY, E

ART UNIT

PAPER NUMBER

1721

DATE MAILED: 05/29/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/888,462

Applicant(s)

Scharf et al

Examiner

Ellen McAvoy

Group Art Unit

1721



☒ Responsive to communication(s) filed on Apr 6, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al (4,594,378).

Applicants' arguments filed April 6, 1998 have been fully considered but they are not persuasive. Applicants argue that the instant claims are directed to lubricating compositions comprising a combination of components which provide a specific value in one of the most severe shear stability test, namely the taper bearing test, and point out that Tipton et al ["Tipton"] contains no disclosure to the degree of shear stability of the lubricating compositions. Applicants further argue that there is no teaching in Tipton which would lead a skilled person to the specific combination of additives required by the instant claims. Applicants' arguments have been fully considered but they are not deemed to be persuasive of patentability since Tipton teaches polymeric compositions suitable for use as transmission fluids and as hydraulic fluids which encompass the claimed polymeric compositions as set forth in the previous office action. And, while not disclosing a specific shear stability test, Tipton teaches the property of shear stability and teaches that the polymeric compositions are characterized as having improved shear stability while maintaining desirable high and low temperature viscosity characteristics. See col. 1, lines

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18-22 and col. 2, lines 5-26 and lines 45-51. Aside from a showing otherwise, the Examiner is of the position that the polymeric compositions of Tipton have the same shear stability as the compositions of the instant claims.

Applicants also argue that Tipton does not teach or suggest the levels of additives required in applicants' claims, and argue that the Examples of Tipton fail to provide the required levels of polymer (A). Polymer (A) is present in claim 1 in an amount of from about 15% to about 40% by weight, and, as set forth in the previous office action, components (A) and (B-2) of Tipton encompass polymer (A) of the instant claims. Applicants' argument is not deemed to be persuasive since Tipton teaches that components (A) and (B-2) combined add to 0.2% to about 30% by weight in either a transmission fluid or a hydraulic fluid which overlaps the range of 15-40% by weight of the instant claims. The compositions of Tipton are not limited to the demonstrative examples.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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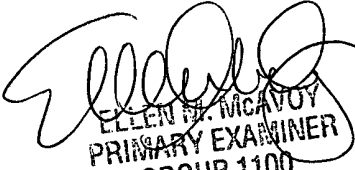
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen McAvoy whose telephone number is (703) 308-2510.

The fax telephone numbers for Group 1700 are (703) 395-3599 for Official After Final Fax, (703) 305-5408 for Official Non-Final Fax and (703) 306-3429 for Unofficial Fax.

EMcAvoy
May 27, 1998


ELLEN M. MCAVOY
PRIMARY EXAMINER
GROUP 1100